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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/619,154

07/14/2003

James Patrick Griffin JR.

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WOLF, BLOCK, SHORR AND SOLIS-COHEN LLP
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EXAMINER

STRIMBU, GREGORY J

ART UNIT

PAPER NUMBER

3634

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/619,154	GRIFFIN, JAMES PATRICK	
	Examiner	Art Unit	
	Gregory J. Strimbu	3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 4 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/6/06, 12/28/06 and 2/15/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-36, 38-46 and 48-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-36, 38-46 and 48-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Drawings

The drawing correction filed December 6, 2006 has been approved.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 50 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 30. Claim 51 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 40. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

Claims 30-36, 38-46 and 48-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "to be received" on line 8 of claim 30 render the claims indefinite because it is unclear what element of the invention is to receive the locking member. Recitations such as "a locking member" on lines 9, 13 and 20-21 of claim 30 render the claims indefinite because it is unclear if the applicant is referring to the locking member set forth above or is attempting to set forth another locking member in addition to the one set forth above. It is suggested the applicant change "a locking member" to --the locking member-- or to --said locking member-- where appropriate throughout the claims to avoid confusion. Recitations such as "is over-bend mounted to the free vertical edge portion of the door" on line 24 of claim 30 render the claims indefinite because it is unclear if the applicant is claiming the subcombination of a security system or the combination of a security system and a door. The preamble of claim 30 implies the subcombination while the positive recitation of the door implies the combination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 50 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by British Patent Application No. 2 265 664. British Patent Application No. 2 265 664 discloses a security system for a doorway comprising a door frame (not numbered, but

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shown in figure 5) constructed in an opening of a wall (not shown) and having two vertical sides, a door jamb attached to and extending the length of one vertical side of the door frame, and a door (not numbered, but shown in figure 5) sized and shaped to fit within the door frame, the door having a front surface, a rear surface, a top surface, a bottom surface, a free vertical edge portion (not numbered, but shown in figure 5 as the portion of the vertical edge portion covered by the first reinforcing member 2), and a hinged vertical edge portion, the free vertical edge portion comprising at least one lockset (not numbered, but shown in figure 5) having a locking member 21 as shown in figure 4 to be received, and the door jamb having at least one opening (not numbered, but shown in figure 4) to receive a locking member 21 from the at least one lockset, the security system comprising: a first U-shaped reinforcing member 2 capable of being securely affixed to the free vertical edge portion of the door, said reinforcing member comprising steel (see page 8, line 33 to page 9, line 2), extending along the full length of the free vertical edge portion of the door, having at least one opening 8 for passage of a locking member 21 from the at least one lockset, and comprising a longitudinally extending base member 5 and two substantially perpendicularly positioned side members 3 and 4, each of the side members having a proximal edge and distal edge and a substantially planar surface extending from the proximal edge to the distal edge, and the base member having a substantially planar surface, and a second reinforcing member 10 capable of being securely affixed to the door jamb, said second reinforcing member having at least one opening 15 for passage of a locking member 21, wherein the U-shaped reinforcing member is over-bend mounted to the free vertical edge portion

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of the door (see page 5, lines 17-18) so that the reinforcing member 2 engages the free vertical edge portion of the door, wherein the second reinforcing member has a length substantially equal to a vertical portion of the door, and wherein force applied against the front or rear surface of the door will be transmitted through at least one locking member to the second reinforcing member and to the door frame.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30-35 and 40-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over British Patent Application No. 2 265 664 in view of Barnes. British Patent Application No. 2 265 664 discloses a security system for a doorway comprising a door frame (not numbered, but shown in figure 5) constructed in an opening of a wall (not shown) and having two vertical sides, a door jamb attached to and extending the length of one vertical side of the door frame, and a door (not numbered, but shown in figure 5) sized and shaped to fit within the door frame, the door having a front surface, a rear surface, a top surface, a bottom surface, a free vertical edge portion, and a hinged vertical edge portion, the free vertical edge portion comprising at least one lockset (not numbered, but shown in figure 5) having a locking member 21 as shown in figure 4 to be received, and the door jamb having at least one opening (not numbered, but shown

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in figure 4) to receive a locking member 21 from the at least one lockset, the security system comprising: a first U-shaped reinforcing member 2 capable of being securely affixed to the free vertical edge portion of the door, said reinforcing member comprising steel (see page 8, line 33 to page 9, line 2), extending along a length of the free vertical edge portion of the door, having at least one opening 8 for passage of a locking member 21 from the at least one lockset, and comprising a longitudinally extending base member 5 and two substantially perpendicularly positioned side members 3 and 4, each of the side members having a proximal edge and distal edge and a substantially planar surface extending from the proximal edge to the distal edge, and the base member having a substantially planar surface, and a second reinforcing member 10 capable of being securely affixed to the door jamb, said second reinforcing member having at least one opening 15 for passage of a locking member 21, wherein the U-shaped reinforcing member is over-bend mounted to the free vertical edge portion of the door (see page 5, lines 17-18) so that the reinforcing member 2 engages the free vertical edge portion of the door, wherein the second reinforcing member has a length, and wherein force applied against the front or rear surface of the door will be transmitted through at least one locking member to the second reinforcing member and to the door frame, the locking member 21 is a dead bolt, a door latch (not numbered, but shown in figure 4 disposed below the dead bolt 21), screws (not shown, but see page 6, line 3). Although British Patent Application No. 2 265 664 discloses that the front and rear sides of the plate 2 may be of any suitable height and width (page 5, lines

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23-31), British Patent Application No. 2 265 664 is arguably silent concerning the lengths of the first and second reinforcing members.

However, Barnes discloses a door security system comprising a reinforcing member B extending the full length of the door.

It would have been obvious to one of ordinary skill in the art to provide the first U-shaped reinforcing member of British Patent Application No. 2 265 664 with a length extending the full length of the door, as taught by Barnes, to increase the strength of the reinforcing member and thus the effectiveness of the security system.

Additionally, one of ordinary skill in the art is expected to routinely experiment with parameters so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been no more than an obvious matter of engineering design choice, as determined through routine experimentation and optimization, for one of ordinary skill to provide the second reinforcing member with a length substantially equal to the full length of the door to match the length the first reinforcing member in order to provide adequate strength to the security system.

Finally, the examiner takes Official notice that a door width of about 1.75 inches is well known in the art.

Claims 36 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over British Patent Application No. 2 265 664 in view of Barnes as applied to claims 30-35 and 40-45 above, and further in view of Stein. Stein discloses a silicon adhesive.

It would have been obvious to one of ordinary skill in the art to provide British Patent Application No. 2 265 664, as modified above, with an adhesive, as taught by Stein, to more securely attach the reinforcing members to the door assembly.

Claims 38 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over British Patent Application No. 2 265 664 in view of Barnes as applied to claims 30-35 and 40-45 above, and further in view of Francis. Francis discloses a second reinforcing member 60 having a tubular member 66 to receive a locking member.

It would have been obvious to one of ordinary skill in the art to provide British Patent Application No. 2 265 664, as modified above, with a tubular member, as taught by Francis, to further increase the strength of the security system.

Claims 39 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over British Patent Application No. 2 265 664 in view of Barnes as applied to claims 30-35 and 40-45 above, and further in view of Zarzycki. Zarzycki discloses a metal door 202.

It would have been obvious to one of ordinary skill in the art to provide British Patent Application No. 2 265 664, as modified above, with a metal door, as taught by Zarzycki, to increase the strength of the door and therefore the strength of the security door assembly.

Response to Arguments

Applicant's arguments filed December 6, 2006 have been fully considered but they are not persuasive.

The declaration of James P. Griffin, Jr. filed December 6, 2006 has been considered and determined not to be persuasive. The applicant alleges the commercial success of the applicant's claimed invention renders the examiner's obviousness rejection moot. Although the declaration indicates that many door systems have been sold, it provides no indication whether the number of door systems sold is a substantial quantity in the market. Evidence related solely to the number of units sold provides a very weak showing of commercial success, if any. Moreover, the applicant is required to establish that the sales of the door system were a direct result of the unique characteristics of the claimed invention, as opposed to other economic and commercial factors unrelated to the quality of the claimed subject matter. In other words, a nexus is required between the sales and the merits of the claimed invention. The applicant must show that the claimed features were responsible for the commercial success of an article if the evidence of non-obviousness is to be accorded substantial weight. Merely showing commercial success of an article which embodied the invention is not sufficient. Accordingly, the applicant has failed to demonstrate the commercial success of the invention.

With respect to the applicant's comments concerning British Patent Application No. 2 265 664, the examiner respectfully disagrees. It should first be noted that British Patent Application No. 2 265 664 discloses that the reinforcing member 2 "may be of

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any suitable height and width" on lines 23-24 of page 5. Therefore, the reinforcing member 2 is not clearly intended to be positioned merely around the locking means as alleged by the applicant. Moreover, claims 30-35 and 40-45 are rejected based on the combination of British Patent Application No. 2 265 664 and Barnes. Therefore, the applicant's comments only against British Patent Application No. 2 265 664 are not persuasive. Additionally, fit snugly is the same as "over-bend mounted". Although the applicant can be his own lexicographer, the applicant has failed to set forth a clear definition of "over-bend mounted". What characteristic of "over-bend mounted" is different from snugly mounted? Therefore, without a more specific definition provided by the applicant, fit snugly is the same as "over-bend mounted". It should be noted that the Larson Tools description only refers to "over-bending" in general and does not refer to "over-bend mounting". The applicant's comments concerning screws are not persuasive because the applicant utilizes screws as well. Thus, the use of screws is not evidence of a snug fit being less than "over-bend mounted".

With respect to the applicant's comments concerning the motivation to combine the teachings of British Patent Application No. 2 265 664 and Barnes, the examiner respectfully disagrees. The invention of Barnes is concerned with increasing the strength of the door at the point that has been weakened by the mortise (see page 1, lines 14-17 of Barnes). Therefore, both British Patent Application No. 2 265 664 and Barnes are concerned with security systems. Moreover, claims 30-35 and 40-45 are rejected based on the combination of British Patent Application No. 2 265 664 and Barnes. Therefore, the applicant's comments only against Barnes are not persuasive.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 571-272-6836. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Cuomo can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Gregory J. Stringfellow", with a long horizontal flourish extending to the right.

Gregory J. Stringfellow
Primary Examiner
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March 6, 2007